REMARKS

The Examiner is thanked for the examination of the application. In view of the remarks that follow, the Examiner is respectfully requested to reconsider and withdraw the rejections.

35 USC 101:

Claims 1, 4, and 5 have been rejected under 35 USC 101 as allegedly not falling within one of four statutory categories of invention, citing *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008). In order to expedite prosecution of the application, claims 1 and 5 have been amended to conform to the test set forth in *In re Bilski*.

Specifically, *In re Bilski* states:

> The Supreme Court, however, has enunciated a definitive test to determine whether a process claim is tailored narrowly enough to encompass only a particular application of a fundamental principle rather than to pre-empt the principle itself. A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.

Accordingly, claims 1 and 5 have been amended to tie the process to a particular machine or apparatus, i.e., an outer surface inspecting apparatus. Therefore, under the test set forth in *Bilski*, the claims are now patent-eligible.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejections under 35 USC 101.

Art Rejections:

Claims 1, 4, 5, 8, and 9 have been rejected under 35 USC 103(a) as being unpatentable over USP 6,952,492, hereinafter *Tanaka*, in view of EP 0643293, hereinafter *Toshiba*.

Claims 1, 5, 8, and 9 recite that the master pattern includes four corner pattern portions and four side pattern portions. Each of the four corner pattern portions (represented in the preferred embodiments as 17a-17d) has two perpendicular edges defining the respective corner portion. And, each of the four side pattern portions (represented in the preferred embodiments as 17e-17h) has a straight edge portion defining a vertical edge or a horizontal edge. However, the present invention is not limited to the preferred disclosed embodiments.

As carefully explained in paragraph [0007] of the published application, the present invention is intended to overcome a problem used when inspections were made using only straight edge portions. If the straight edge portions extended beyond the corner of the view area of the chip, an erroneous rejection was made. As explained in paragraph [0013] of the published application, because the master pattern includes corner portions as well as straight portions, the straight portions can be used repeatedly across the straight edges of the chip until it reaches the corner, and the corner portions are used to inspect the corners of the chip. As a result, the straight portions cannot erroneously extend beyond the corners of the chips and give false rejections.

By including each of the four corner pattern portions and each of the four side pattern portions of the master pattern as described above, the nine standard pattern

portions of the master pattern can be easily matched with the inspection view areas, respectively, without requiring severe positional alignment.

See, for example, paragraph [0039] of the published application, which states:

> To the contrary, according to the present invention of this application, since the information on the edge shapes and the exterior areas are correspondingly contained in the standard pattern portions 17a to 17h on the peripheral portion excluding the central pattern portion 17i, no severe positional alignment needs not be done unlike in the prior art. Therefore, the peripheral standard pattern portions 17a to 17h can be positionally aligned at a relatively large allowable error, that is, with the same allowable error as in the case of the central pattern portion 17i, so that erroneous judgment due to the error in this alignment is avoided. As a result, the occurrence of the erroneous judgment due to the error in arrangement of the standard pattern portion 17a to 17h constituting the master pattern 17 is avoided, and the effective surface inspection can be performed.

Accordingly, it is the combination of ***both*** the corner pattern portions and the side pattern portions that enables the present invention to work both efficiently and accurately, minimizing false or erroneous rejections.

On the other hand, in *Tanaka*, only five checking positions including four corners and a center are disclosed. Therefore, *Tanaka* does not disclose the four corner pattern portions and the four side pattern portions as in the present invention.

The Office Action tries to overcome this deficiency be relying on *Toshiba* for allegedly teaching "edge detection". However, "edge detection" is not what is missing from *Tanaka*. What the prior art does not teach, either singly or in combination, is the concept of using ***both*** the corner pattern portions and the side pattern portions so that the inspection can take place efficiently, and without the risk of the side pattern portions running past the corners and giving erroneous rejections.

Therefore, Applicants submit that the present invention significantly differs from the technology described in *Tanaka* and *Toshiba* in the structure and technical

effect, and is not easily made based on the technical matters set forth in the applied art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejections.

In the event that there are any questions concerning this Amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Respectfully submitted,

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